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10/528,985

03/24/2005

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04/16/2007

EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1751

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/528,985

Applicant(s)

SALLWEY ET AL.

Examiner

Eisa B. Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/24/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1751

Claims 1-9 are pending in this application.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36 and 37 of U.S. Patent No. 7,189,265 B2 and claims 1 and 2 of U.S. Patent No. 5,688,291. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the US. Patent No. 7,189,265 B2 and US Patent No. 5,688,291, teach and disclose similar compositions for simultaneously lightening and coloring hair comprising peroxy salts and disperse dyes selected from azo dyes as claimed in claims 1 and 4 (see claims 36 and 37 of the US. Patent No. 7,189,265 B1 and claims 1 and 2 of the US. Patent No. 5,688,291). Therefore, this is an obvious formulation.

Art Unit: 1751

Although, the claims of the US. Patents No. 7,189,265 B1 and 5,688,291, teach and disclose similar compositions, they are not identical to the instant claims because the claims of instant claims reciting general genus of dyes, while the claims of the US Patent No. 7,189,265 B1 and 5,688,291, teach and disclose more specific dyes in compositions. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate such a dyeing composition because the claims of the US. Patent No. 7,189,265 B1 and 5,688,291, teach and disclose similar dyeing compositions comprising species of the claimed dyes and, thus, a person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent unexpected results.

Claim Rejections - 35 USC § 102

2 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Imperial (US 2002/0004957 A1).

Imperial (US' 957 A1) teaches a composition for simultaneous coloring and highlighting hair comprising 1-20% of inorganic persulfate (peroxy salt) as claimed in claims 1, 4 and 5 (see page 2, paragraphs, 0027 and 0034), wherein the composition also comprises azo dyes in the claimed amounts as claimed in claims 1 and 3 (see page 2, paragraph, 0029 and page 5,

Art Unit: 1751

Paragraph, 0089) and wherein the composition has a pH in the range of 11 to 11.5% which within the claimed range as claimed in claim 6 (see page 10, paragraph, 0185). Imperial (US' 957 A1) teaches all the limitations of the instant claims. Hence, Imperial anticipates the claims.

3 Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Said et al. (US 5,688,291).

Said et al. (US' 291) teaches a composition for simultaneously lightening and coloring hair comprising potassium persulfate and an azo dye 2-[4-ethyl-(2-hydroxyethyl)-amino]-2-methylphenylazo]-5-nitro-1,3-thiazole (Disperse Blue 106) as claimed in claims 1-2, and 4 (see cols. 13-14, Examples 1 and 4), wherein the persulfate and the azo dye are present in the composition in the claimed amounts as claimed in claims 3 and 5 (see cols. 13-14, Examples 1 and 4). Said et al. (US' 291) teaches all the limitations of the instant claims. Hence, Said et al. anticipates the claims.

4 Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Orr (US 2002/0050012 A1).

Orr (US' 012 A1) teaches a composition for simultaneously lightening and coloring hair comprising potassium persulfate and azo dyes in the claimed amounts as claimed in claims 1 and 3-5 (see page 4, paragraphs, 0040-0042 and page 6, claim 20). Orr (US' 012 A1) teaches all the limitations of the instant claims. Hence, Orr anticipates the claims.

5 Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Klusch et al. (DE 19721785).

Klusch et al. (DE' 785) teaches a composition for simultaneously dyeing and brightening of hair comprising direct dyes and persulfate as claimed in claim 1 (see English

Art Unit: 1751

Abstract of the Patent No. DE 19721785). Goldwell Gmbh teaches all the limitations of the instant claim. Hence, Goldwell Gmbh anticipates the claim..

6 Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Said et al. (WO 02/074270 A1).

Said et al. (WO' 270 A1) teaches a composition for simultaneously lightening and coloring hair comprising potassium persulfate and dyes of 1-[4-amino-3,5-dimethylphenyl)-(2,6-dichlorophenyl)methylene]-3,5-dimethyl-4-imino-2,5-cyclohexadiene phosphoric acid(1:1) (Basic Blue 77) and 2,4-dinitro-1naphthol sodium salt (Acid Yellow 24) as claimed in claims 1-2, and 4 (see page, 9, Table 1 and page 16, Example 4), wherein the persulfate and the dyes are present in the composition in the claimed amounts as claimed in claims 3 and 5 (see page 9, Table 1 and page 16, Example 4). Said et al. (WO' 270 A1) teaches all the limitations of the instant claims. Hence, Said et al. anticipates the claims.

Claim Rejections - 35 USC § 103

7 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imperial (US 2002/0004957 A1).

Imperial (US' 957 A1) teaches a composition for simultaneous coloring and highlighting hair comprising 1-20% of inorganic persulfate (peroxy salt) (see page 2, paragraphs, 0027 and 0034), wherein the composition also comprises azo dyes (see page 2, paragraph, 0029 and page

Art Unit: 1751

5, paragraph, 0089). The composition further comprises 1-20% hydrogen peroxide (see page 2, paragraph, 0028), and wherein the hydrogen peroxide is mixed with the dyeing composition at the time of use (see page 9, Example 1).

The claims differ from the reference by reciting a two-compartment kit consisting of the claimed dyeing ingredients (colorant and hydrogen peroxide).

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such a kit for maintaining the dyeing composition by separating the dyeing composition in a container separate from the oxidizing agent container because Imperial (US' 957 A1) clearly teaches that the colorant composition is mixed with the developer (oxidizing) composition at the time of use (see page 10, paragraph, 0185) which implies that the coloring composition is maintained in a container differs from the one that occupied with the developer (oxidizing) composition, and, thus, a person of the ordinary skill in the art would be motivated to separate the dyeing composition using devices similar to those claimed, and would expect such a device to have similar properties to those claimed, absent unexpected results.

Conclusion

8 The remaining references listed on from PTO-1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

Art Unit: 1751

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Eisa Elhilo
Primary Examiner
Art Unit 1751

April 12, 2007